

REMARKS

I. General

Claims 1 – 55 are presently pending in the application. The issues in the current Office Action are as follows:

- Claim 43 is rejected under 35 U.S.C. § 112.
- Claims 1 – 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0103935 to Fishman et al. (hereinafter “Fishman”) in view of U.S. Patent Publication No. 2003/0097463 to Kageyama et al. (hereinafter “Kageyama”) and further in view of U.S. Patent Publication No. 2005/0038892 to Huang et al. (hereinafter “Huang”).
- Claims 10, 32 and 43 – 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0193951 to Fenton et al. (hereinafter “Fenton”) in view of Fishman.
- Claims 11 – 21, 24 – 29, 31, 33 – 42 and 45 – 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton and Fishman as applied to parent claims 10 and 32 above, and in view of U.S. Patent Publication No. 2004/0249768 to Kontio et al. (hereinafter “Kontio”).
- Claims 22 – 23 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton, Fishman and Kontio as applied to parent claim 24 above, and in view of U.S. Patent Publication No. 2005/0256937 to Lewis (hereinafter “Lewis”).
- Claim 51 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama in view of Fenton.

- Claims 52 – 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama and Fenton as applied to parent claim 51 above, and in view of Kontio.

Applicant appreciates the courtesy and professionalism extended by the Examiner thus far. Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the amendments and remarks contained herein.

II. Claim Amendments

Claims 1 and 10 have been amended to make the claims clearer. Support for the subject matter of these amendments may be found at least at paragraphs [0007], [0032] and [0048]. Claim 51 has been amended to make the claim clearer and to recite, “wherein said portion of multi-media content is not received, in said host remote, from said user” Support for these amendments to claim 51 may be found at least at paragraph [0007]. Claim 43 has also been amended to remove the word “may” further to the 35 U.S.C. § 112 rejection noted below. No new matter has been added by these amendments.

III. Claim Rejections

A. 35 U.S.C. § 112 Rejection

Claim 43 is rejected under 35 U.S.C. § 112. As noted above, claim 43 has been amended to remove the word “may.” Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 112, of claim 43.

B. 35 U.S.C. § 103(a) Rejection

Claims 1 – 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable. In an obviousness rejection, “[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*, 383 U.S. 1, 15 - 17 (1966). The nonobviousness of each of the rejected claims is discussed below.

1. 35 U.S.C. § 103(a) Rejection over Fishman in view of Kageyama and further in view of Huang

Claims 1 – 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fishman in view of Kageyama and further in view of Huang.

2. Independent claim 1

a. The current interpretation of Fishman to meet claim 1 is flawed

Prior to the amendment to claim 1, the claim recited, “storing, in a media delivery system, content to be delivered to said second user device, wherein said stored content is received from a device other than said first user device” In an attempt to show Fishman meets this limitation, the Examiner asserts that

Fishman discloses . . . said stored content is received from a device other than first user device 4. . . Gateway receives the content to deliver it to devices A, B or C

Office Action, page 4. (emphasis original). However, in asserting Fishman teaches another limitation of claim 1 that recites, “accepting information from said first user device with respect to said stored content”, the Examiner asserts that

accepting information from said first user device with respect to said stored content to be delivered to said second user device (Fishman, Fig. 2, gateway-250, where gateway receives the content from content server and delivers it to second user e.g. devices A, B or C).

Office Action, page 4. Here, the Examiner relies on gateway 250 for teaching the first user device for the latter limitation, yet in discussing the former limitation, the Examiner asserts that gateway 250 teaches a device other than the first user device. The Examiner also relies on gateway 250 for teaching, “performing media negotiation with a system associated with said second user device to inform said media delivery system of attributes of said second user device” Office Action, page 5. The Examiner’s reliance on gateway 250 to teach several different elements of claim 1 is contradictory and shows that the structure relied upon

to meet the claim limitations is not arranged as required by the claims. These contradictory statements show that the Examiner is relying on impermissible hindsight reconstruction to pick and choose disclosures from the art to deprecate the claimed invention. *See In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784.

Moreover, the Applicant respectfully submits that the Examiner's interpretation of gateway 250 as a user device is unreasonable and also reflects improper hindsight reconstruction. One skilled in the art, applying the ordinary meaning of "user device" to the claim language, would never read Fishman and conclude that Fishman's gateway 250 meets a user device, as the Examiner has done. For example, the Examiner asserts gateway 250 is a "user device" despite disclosures in Fishman discussing gateway 250 carrying out a function for actual user devices:

FIG. 2 shows mobile gateway 250 customizing email content for various mobile clients, such as phone 274, pager 276, and PDA 278. Email content may include various mailbox summaries (e.g., inbox, sent, saved, etc.) and is but one example of the content that may be customized by mobile gateway 250.

Fishman, paragraph [0033]. Based on this portion of Fishman alone, one skilled in the art would distinguish between gateway 250 and mobile clients such as a phone, pager and a PDA and thereby not conclude Fishman's gateway 250 meets the "user device" of the claims. In sum, the Examiner's interpretation of Fishman is contradictory and cannot be relied on to meet the limitations of claim 1. At least for these reasons, the current obviousness rejections relying on Fishman are improper, does not establish a prima facie case of obviousness and should be withdrawn.

b. The amendments clarifies the claims and highlights the distinctions between the claims and the art

Despite the fundamental flaws in the current rejection of claim 1, the Applicant has amended claim 1 to make claim 1 even clearer and thus expedite prosecution. For example, claim 1, as amended, requires, "storing, in a media delivery system, content to be delivered to said second user device, wherein said stored content is received, in said media delivery

system, from a device other than said first user device. . . .” The Examiner relies on Fishman for teaching that the stored content is received from a device other than the first user device. Office Action, page 4. The current amendment, however, makes clear that the receipt that this limitation refers to is the receipt in the media delivery system, not receipt by the second user device as the Examiner seems to be arguing. Fishman does not teach the stored content is received, in the media delivery system, from a device other than the first user device because there is no showing in Fishman that content store 230 receives stored content that is delivered to devices 274, 276 and 278 other than from the device that sends the e-mail data object to devices 274, 276 and 278.

Fishman also fails to teach, “performing media negotiation between said media delivery system and a system associated with said second user device to inform said media delivery system of attributes of said second user device” In Fishman, the asserted media delivery system (content server 210) does not perform media negotiation. Instead, the Examiner asserts gateway 250 does media negotiation. Office Action, page 5. Significantly, the Examiner also relies on gateway 250 as a user device. Office Action, pages 4 – 5. Because gateway 250 is asserted as being a user device, gateway 250 is not a part of the media delivery system. Thus, Fishman fails to teach, “performing media negotiation between said media delivery system and a system associated with said second user device to inform said media delivery system of attributes of said second user device”

Kageyama does not cure Fishman’s deficiencies. Specifically, Kageyama fails to teach, “storing, in a media delivery system, content to be delivered to said second user device, wherein said stored content is received, in said media delivery system, from a device other than said first user device. . . .” Kageyama teaches a user device capable of negotiations pertaining to the disclosure of attribute information. Abstract. The user device negotiates with a center device the information that may be shared with a second device. *Id.*, paragraph [0057]. Kageyama, however, does not show that information stored is received, in the media delivery system, from a device other than the first user device or a first user (*e.g.*, the user device or user from which a message is accepted with respect to the stored content). Thus, Kageyama fails to teach, “storing, in a media delivery system, content to be delivered to said

second user device, wherein said stored content is received, in said media delivery system, from a device other than said first user device”

Further, claim 1 requires, “performing media negotiation between said media delivery system and a system associated with said second user device to inform said media delivery system of attributes of said second user device” However, the attribute information of Kageyama does not relate to a device; it pertains to a user. *See* Abstract (stating, “users’ attribute information to external devices and the input of others’ attribute information from external devices.”); paragraph [0060]. Therefore, Kageyama fails to cure Fishman’s failure to teach “performing media negotiation between said media delivery system and a system associated with said second user device to inform said media delivery system of attributes of said second user device”

Furthermore, Huang is directed to apparatus and method for performing wireless communication and the Applicant’s review of Huang does not reveal that Huang cures Fishman’s and Kageyama’s failure to teach all the limitations of claim 1. In sum, Fishman in view of Kageyama and further in view of Huang do not teach all the limitations of claim 1. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claim 1.

3. Dependent claims 2 – 9

Dependent claims 2 – 9 depend either directly or indirectly from independent claim 1, and thus inherit all of the limitations of claim 1. It is respectfully submitted that dependent claims 2 – 9 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Moreover, the dependent claims recited limitations not taught by the cited references.

For example, claim 2 recites “wherein said first user device and said second user device are associated with a same user, and wherein said first user device and said second user device provide said content to said user using different media modes.” Claim 5 recites, “wherein said first user device and said second user device provide said content to respective

users thereof using different media modes.” Examiner relies on Fishman Fig. 2, elements A, B, C and paragraph [0004] for teaching these limitations of claims 2 and 5.

These cited portions of Fishman, however, do not teach the limitations of claims 2 and 5. Instead, these portions of Fishman merely show the different user devices that can be used in Fishman and that a user may own several of these user devices. Therefore, Fishman does not teach the limitation of claim 2 requiring “wherein said first user device and said second user device are associated with a same user, and wherein said first user device and said second user device provide said content to said user using different media modes.” Similarly, Fishman also fails to teach the limitation of claim 5 requiring “wherein said first user device and said second user device provide said content to respective users thereof using different media modes.”

In sum, the cited references do not teach all the limitations of claims 2 – 9. Accordingly, the Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2 – 9.

C. 35 U.S.C. § 103(a) Rejection over Fenton in view of Fishman

Claims 10, 32 and 43 – 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton in view of Fishman.

1. Independent claim 10

Claim 10, as amended, requires, “wherein said stored content is received, in said server, from a device other than said first user device.” The Examiner concedes that Fenton does not teach this limitation and relies on Fishman for teaching it. Office Action, page 8. However, Fishman does not teach this limitation. Fishman teaches that the content stored in content server 210 (Fig. 2, e-mail data object to A, B and C), is sent by a device that also sends the request to send the stored content to the user. Abstract, paragraph [0034]. Specifically, all the content stored on content server 210 and any request to deliver that content to asserted second user devices 274, 276 and 278, is sent from the same device, in contrast to the requirements of claim 10. Therefore, Fishman does not teach “wherein said stored content is received, in said server, from a device other than said first user device.”

In sum, the combination of Fenton and Fishman does not teach all the limitations of claim 10. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claim 10.

2. Independent claims 32 and 43

Claim 32, recites “after said storing and identifying, receiving, at said server . . . identification of certain content of said stored content for sending. . . .” Claim 43, as amended, recites, “wherein said receiving occurs after said content has been stored and uniquely identified.” The Examiner has not shown that Fenton in view of Fishman teaches this limitation. In fact, the Examiner discusses claims 32 and 43 with claim 10 without addressing the above limitations of claims 32 and 43.

Fenton discloses a system for processing multimedia messages. Abstract. In Fenton, when a message is received, a determination is made whether the multimedia message should be processed using a customized process. *Id.* Additionally, a multimedia message and delivery information regarding that multimedia message in Fenton is delivered contemporaneously. Paragraph [0041]. As such, Fenton does not teach after said storing and identifying, receiving identification of certain content.

Fishman does not cure the deficiencies of Fenton. Fishman discloses content store 230 receives email data object to A, B and C but does not disclose that after content store 230 receives e-mail data object to A, B and C, receiving at content store 230, identification of certain content for sending. As such, Fishman also does not teach the limitation of claim 32 requiring that after said storing and identifying, receiving identification of certain content. Similarly, Fishman does not teach the limitation of claim 43 requiring receiving occurs after said content has been stored and uniquely identified. In sum, the Examiner has not shown that Fenton in view of Fishman teach all the limitations of claims 32 and 43. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claims 32 and 43.

3. Dependent claim 44

Dependent claim 44 depends from independent claim 43, and thus inherits all of the limitations of claim 43. It is respectfully submitted that dependent claim 44 is allowable at least because of its dependence from claim 43 for the reasons discussed above. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 44.

D. 35 U.S.C. § 103(a) Rejection over Fenton and Fishman in view of Kontio

Claims 11 – 21, 24 – 29, 31, 33 – 42 and 45 – 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton and Fishman as applied to parent claims 10 and 32 above and in view of Kontio.

1. Dependent claims 11 – 21, 24 – 29, 31, 33 – 42 and 45 – 50

Dependent claims 11 – 21, 24 – 29 and 31 depend either directly or indirectly from independent claim 10, and thus inherit all of the limitations of claim 10. Dependent claims 33 – 42 depend either directly or indirectly from independent claim 32, and thus inherit all of the limitations of claim 32. Dependent claims 45 – 50 depend either directly or indirectly from independent claim 43, and thus inherit all of the limitations of claim 43. As discussed above, Fenton in view of Fishman does not teach all the limitations of claims 10, 32 and 43. Kontio also does not appear to teach these limitations. Kontio is directed to protecting the intellectual property rights of content producers. Abstract and paragraphs [0002] – [0008]. As such, access, copying and transfer of digital asset is controlled by digital vouchers. Paragraph [0029]. The voucher is used to allow a mobile device to access the content and download it. Paragraphs [0032] – [0033]. The mobile device may also send a voucher to a voucher network “which transforms the identity of the custodian specified in the voucher from the distributing computer to the receiving terminal.” Paragraph [0034]. “The receiving terminal can then download the content from the distributing terminal, based on the terms specified in the voucher.” *Id.*

Therefore, Konia’s teaching of devices downloading content, based on a voucher provided by the downloading device or another device, does not teach that the content is sent

or delivered to a second user device based on a message from a first user device. Sending content to a device or user is different from that device or user taking active steps to download content. As such, Kontio is insufficient to cure Kageyama's and Fenton's failure to teach the limitations of claim 10, 32 and 43. Therefore, Fenton in view of Fishman and further in view of Kontio does not teach all the limitations of claims 11 – 21, 24 – 29 and 31. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11 – 21, 24 – 29 and 31.

E. 35 U.S.C. § 103(a) Rejection over Fenton, Fishman and Kontio and in view of Lewis

1. Dependent claims 22 – 23 and 30

Claims 22 – 23 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fenton, Fishman and Kontio as applied to parent claim 24 above, and in view of Lewis. Dependent claims 22 – 33 and 30 depend either directly or indirectly from independent claim 10, and thus inherit all of the limitations of claim 10. As discussed above, Fenton in view of Fishman and Kontio do not teach all the limitations of claim 10. Lewis does not appear to cure Fenton in view of Fishman and Kontio's failure to teach all the limitations of claim 10 as Lewis involves the use of a replicating device to transfer information between a master device and a third party device. Abstract, paragraph [0008]. Therefore, Fenton in view of Fishman, Kontio and Lewis does not render claims 22 – 33 and 30 obvious. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 22 – 33 and 30.

F. 35 U.S.C. § 103(a) Rejection over Kageyama in view of Fenton

1. Claim 51

Claim 51 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama in view of Fenton. Claim 51, as amended requires, "wherein said portion of multi-media content is not received, in said host remote, from said user" Kageyama teaches a device capable of negotiation regarding the disclosure of attribute information. Abstract. The Kageyama system essentially comprises three main parts—two user terminals and a center

device. Abstract, Fig. 2. However, the attribute information that is shared passes from one terminal through the center device to another terminal. *See* Abstract, paragraph [0058]. Thus, anything regarding a first terminal received by a second terminal originates from the first terminal. As such, Kageyama does not teach, “wherein said portion of multi-media content is not received, in said host remote, from said user”

Moreover, as discussed above, the Examiner concedes “Fenton however is silent on disclosing explicitly, wherein said stored content is received from a device other than said first user device.” Office Action, page 9. Therefore, Fenton also does not teach, “wherein said portion of multi-media content is not received, in said host remote, from said user” In sum, Kageyama in view of Fenton does not teach all the limitations of claim 51. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 51.

G. 35 U.S.C. § 103(a) Rejection over Kageyama and Fenton and in view of Kontio

1. Dependent claims 52 – 55

Claims 52 – 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kageyama and Fenton as applied to parent claim 51 above, and in view of Kontio. Dependent claims 52 – 55 depend either directly or indirectly from independent claim 51, and thus inherit all of the limitations of claim 51. As discussed above, Kageyama in view of Fenton does not teach all the limitations of the claims. Based on the Applicant’s reading of Kontio, Kontio does not cure the deficiencies of Kageyama in view of Fenton. Kontio is directed to protecting the intellectual property rights of content producers. Abstract and paragraphs [0002] – [0008]. As such, access, copying and transfer of digital asset is controlled by digital vouchers. Paragraph [0029]. The voucher is used to allow a mobile device to access the content and download it. Paragraphs [0032] – [0033]. The mobile device may also send a voucher to a voucher network “which transforms the identity of the custodian specified in the voucher from the distributing computer to the receiving terminal.” Paragraph [0034]. “The receiving terminal can then download the content from the distributing terminal, based on the terms specified in the voucher.” *Id.*

Kontio's teaching of devices downloading content, based on a voucher provided by the downloading device or another device, does not teach that the content is sent or delivered to a recipient based on a message from a user. As such, Kontio is insufficient to cure Kageyama's and Fenton's deficiencies. In sum, Kageyama and Fenton and in view of Kontio does not render claims 52 – 55 obvious. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claims 52 – 55.

IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. Please charge any fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 64032/P006US/10303189 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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